

REMARKS

This is intended as a full and complete response to the Office Action dated June 4, 2004, having a shortened statutory period for response set to expire on September 4, 2004. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-46 are pending in the application. Claims 1-28 and 30-46 remain pending following entry of this response. Claims 1-2, 10, 16, 21 and 25 have been amended. Claims 29-32 have been cancelled. Applicants submit that the amendments do not introduce new matter.

Claims 1-3, 7-16, 18-23, 25-26, 28-36, 38-40 and 44-46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Wen-Syan Li* (US 6,725,227; hereinafter *Li*) in view of *Kim* (US 6,546,002). Applicant respectfully traverses the rejection.

As an initial matter, Applicant requests a clarification of the Examiner's rejection. The Examiner first asserts that *Li* teaches each element of claim 1. (Page 2 of the Examiner's Action.) Immediately thereafter, the Examiner concedes that *Li* "does not explicitly state that the URL includes the user interactions necessary to achieve the final destination." (*Id.*) Accordingly, it is not clear what the Examiner believes is taught by *Li*. Applicant respectfully request clarification.

In any case, Applicant submits that a prima facie case of obviousness has not been established. A prima facie case of obviousness requires that the prior art references, when combined, must teach or suggest all the claim limitations. MPEP § 2143.03. In this case, *Li* and *Kim*, alone or in combination, do not teach or suggest all the claim limitations. Accordingly, Applicant respectfully submits that the rejection is improper and requests that the rejection be withdrawn and the claims be allowed.

The Examiner cites Figure 19 and column 5, lines 41-67 of *Li*. Figure 19 is a display window showing query results, as is evidenced by the title ("Query Results") of Figure 19. In particular, the displayed query results are those documents that are "refreshed or loaded into WebDB 112 since the prior notification" for a subscription-notification process. (Col. 15, lines 60-62.) Column 5, lines 41-67 describes Figure 2 which illustrates the model and structure of Web documents in the document

management system 100 of *Li*. (See, column 5, lines 44-46.) Accordingly, neither of the aspects of *Li* relied upon by the Examiner teach storing portions of a bookmark. In fact, where *Li* teaches bookmarking, such as with respect to Figure 4, the bookmarking is accomplished by selecting a URL from a list 407 displayed in a browsing window 400. (Column 7, lines 1-10; Figure 4.) The displayed URLs are query results returned by a document generator 2102. (Column 6, lines 55-67.) Thus, the bookmarks of *Li* are not generated as a series of portions. Further, no part of the bookmark of *Li* is reflective of user interactions. Rather, the entire URL to be bookmarked is returned as a query result without any requirement of the user having navigated to any particular resource located at the URL. In this regard, Applicant traverses the Examiner's characterization of what the Examiner submits is well-known to one ordinary skill in the art regarding bookmarked addresses. Specifically, the Examiner submits that a bookmarked network address includes a base address and "subsequent navigations by the user separated by a slash". In fact, the slashes represent a hierarchy of a file structure, not a user's navigation. Further, it is precisely this form of a URL, as represented in Figure 19 of *Li*, that presents the deficiency embodiments of the invention address. As described in the Background portion of the present Application, some network resources cannot be effectively bookmarked because no static URL is associated with the resource (such as in the case of generated content from a common gateway interface). The URLs of *Li*, and relied upon by the Examiner, are static URLs. Therefore, Applicant respectfully submits that the rejection is improper and requests that the rejection be withdrawn and the claims be allowed.

Further, Applicant respectfully submits that the Examiner's characterization of *Kim* is incorrect. The Examiner argues that *Kim* teaches an event handler recording user interactions, citing column 12, lines 39-55. In fact, *Kim* makes no mention of recording user interactions by the event handler. *Kim* describes the event handler as waiting for an input command, receiving an input command, decoding the input command and then activating appropriate handler to handle the command. (Column 12, lines 40-46.) Thus, the input received by the event handler is immediately consumed, not recorded. Further, *Kim* does not teach that the event handler performs

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bookmarking. Therefore, Applicant respectfully submits that the rejection is improper and requests that the rejection be withdrawn and the claims be allowed.

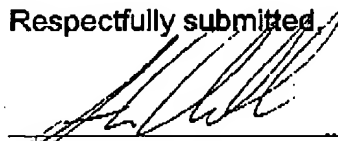
Claims 4-6, 17, 24, 27, 37 and 41-43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Wen-Syan Li* in view of *Kim*, further in view of *DeGreef et al.* (US 6,549,217). Applicant respectfully traverses the rejection.

A prima facie case of obviousness requires some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to combine reference teachings. MPEP § 2143.01. Further, the "initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done"... and..."It is the duty of the Examiner to explain why the combination of the teachings is proper." MPEP § 2142. In this case, the Examiner has provided no support for motivation to combine. In addition, the rejection is believed to have been overcome for the reasons given above with respect to *Li* and *Kim*. Therefore, Applicant respectfully submits that the rejection is improper and requests that the rejection be withdrawn and the claims be allowed.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicant's disclosure than the primary references cited in the office action. Therefore, Applicant believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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